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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,756	06/20/2006	Lothar Mueller	GK-ZEI-3294/50343.20315	2601
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REED SMITH, LLP				
ATTN: PATENT RECORDS DEPARTMENT				
599 LEXINGTON AVENUE, 29TH FLOOR				
NEW YORK, NY 10022-7650				
EXAMINER				
GREECE, JAMES R				
ART UNIT		PAPER NUMBER		
2873				
MAIL DATE		DELIVERY MODE		
03/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,756

Applicant(s)

MUELLER ET AL.

Examiner

JAMES R. GREECE

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Applicant cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/16/2008 has been entered.

Status of the Application

Claims 8-9 and 11-14 are pending in this application

If the applicant is aware of any prior art or any other co-pending application not already of record, he/she is reminded of his/her duty under 37 CFR 1.56 to disclose the same.

Drawings

There are no objections to applicant's drawings at this time.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2873

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 8-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mecklenborg et al (USPAT 3,985,422 of record).

In regard to claim 8, Mecklenborg et al discloses:

A lens system of at least four lenses; (See figure 7) at least two lenses of these at least four lenses being tilted with respect to their optical axes relative to the illumination beam path and imaging beam path; (See figure 7, B and C or D and E) the optical axes of said two lenses and optical axis of the illumination beam path and imaging beam path lying in a first plane; (See figure 7, B and C or D and E) at least two other lenses of the at least four lenses being tilted with respect to their optical axes relative to the illumination beam path and imaging beam path; (See figure 7, B and C or D and E) and the optical axes of the two other lenses and optical axis of the illumination beam path and imaging beam path lying in a second plane which intersects the first plane substantially along the optical axis of the illumination beam path and imaging beam path (See figure 7, B and C or D and E). Wherein the optical axis of the illumination beam path and imaging beam path penetrates the lenses outside their optical axes (See figure 7, B and C or D and E).

In regard to claim 9, Mecklenborg et al discloses:

The first plane and the second plane extend substantially perpendicular to one another (See figure 7, B and C or D and E).

In regard to claim 11, Mecklenborg et al discloses:

The optical axes of the lenses are arranged outside the beam bundle of the illumination beam path and imaging beam path (See figure 7, note the optical axis of the system).

Although Mecklenborg et al does not explicitly teach its device in a Fundus camera, this intended use is insinuated however and is not a requirement in the applicant's claim preamble and if it were a preamble is generally not accorded any patentable weight where it merely recites

the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mecklenborg et al (USPAT 3,985,422 of record) as applied to claim 8 above, and further in view of Howell (USPAT 2,978,956 of record).

In regard to claim 12 Mecklenborg et al fails to explicitly disclose as claimed:

The lenses comprise lens segments.

However Howell discloses lenses comprising lens segments (See Howell figure 1.)

It would have been obvious to one having ordinary skill in the art of lens device design at the time of the invention was made to utilize a lens or lenses comprising lens segments as taught by Howell in the device of Mecklenborg et al since Howell states in column 1, line 22-25 that such a modification would provide the predictable result of a lens system having broader spectral transmittance than is achievable through the employment of a standard lens single lens element.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mecklenborg et al (USPAT 3,985,422 of record) as applied to claim 8 above, and further in view of Humphrey (USPAT 4,730,910 of record).

In regard to claim 13, Mecklenborg et al does not explicitly teach the following as claimed:

At least one of the lenses has an aspheric surface.

However Humphrey teaches this limitation (for details see figure 3G lens A as one of the examples in Humphrey.)

It would have been obvious to one having ordinary skill in the art of optical design to modify the device of Mecklenborg et al to include at least one aspheric lens as taught by Humphrey for the predictable result of providing substantial balance of all aberrations, dispersions and absorptions to the extent of preserving essentially symmetrical optical performance.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mecklenborg et al (USPAT 3,985,422 of record).

In regard to claim 14, Mecklenborg et al fails to explicitly disclose the following as claimed:

At least one lens is replaced by a diffractive optical element.

However the examiner takes official notice to the fact that the use of diffractive elements is well known in the art of fundus camera design and would have been an obvious design choice for one having ordinary skill in the art. A reference supporting this notice is USPAT 2,586,973.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations (Fundus Camera) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Response to Arguments

10. Applicant's arguments filed 1/16/2008 have been fully considered but they are not persuasive.

11. The applicant's main argument and the majority of the applicant's supporting arguments can be summed up in the applicant's remarks as follows *"The Mecklenborg patent, entitled 'Revolutionary Scheimpflug Visual Probe,' is not directed to a fundus camera, and the optical system therein differs substantially from that which is required in an optical fundus camera. Accordingly, Mecklenborg is not a viable reference against applicants' claimed invention and the rejections are not supported."* This argument is not persuasive because of how the applicant actually incorporates "fundus camera" into their claims. To begin the applicant's claim language regarding a fundus camera is as follows *"An optical system, such as for a fundus camera"*. This claim language is indefinite and does not specifically require the device to be used in a fundus camera. Therefore any arguments containing the premise that the device is required to be used in a fundus camera are not persuasive.

Secondly, in response to applicant's arguments, the recitation "fundus camera" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., intermediate image, no movement between elements, every single lens is tilted with different angles and argument 7) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. The applicant's argument related to the lenses of Mecklenberg (of record) are clearly lying in different planes and the applicant is making an argument based on frame of reference which is a non-persuasive argument since it does not limit the claim because different viewers would determine the lenses to be in different planes or the same plane based upon their point of view.

14. The applicant's argument regarding "*the optical axis of the illumination beam path and imaging beam path penetrates the lens outside their optical axes.*" is not persuasive due to the fact that figure 7 of Mecklenborg discloses the optical axis of the system penetrating below the optical axis of the first lens of C and above the optical axis of the second lens of B.

15. Regarding the applicant's argument related to the Howell reference that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies ("incomplete" lens segments) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES R. GREECE whose telephone number is (571)272-3711. The examiner can normally be reached on M-Th 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2873

James R Greece

Patent Examiner

571-272-3711

/J. R. G./

Examiner, Art Unit 2873

3/13/2008

/Joseph Martinez/

Patent Examiner, Art Unit 2873